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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional):
62926, US, (7593)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a))

on _____

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Application Number
10/705, 315Filed
10/10/2003

First Named Inventor

Rammath N. Iyer

Art Unit

3731

Examiner

Amy T. Lang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor: assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record: 44,990
Registration number _____ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Leah O. Robinson

Signature

Leah O. Robinson

Typed or printed name

865.546.4305

Telephone number

June 7, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required. see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Application No.: 10/705,316
Atty Docket No. : 62026.US
Client Docket No.: EI-7595

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Ramnath N. IYER et al.

Examiner: Lang, Amy T.

Application No.: 10/705,316

Art Unit: 1714

Date Filed: November 10, 2003

Confirmation No.: 4450

Title: LUBRICANT COMPOSITIONS
FOR POWER TRANSMITTING FLUIDS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O Box 1450
Alexandria VA 22313-1450

Sir:

In response to the final office action dated January 09, 2007, and Advisory Action mailed March 26, 2007, Applicants hereby respectfully request consideration of the arguments presented in this Pre-Appeal request and request favorable action in response thereto.

This response is believed to be timely filed with a two-month extension, as it is being filed within five months of the mailing date of the present Office Action.

REMARKS

The invention, as defined by the currently pending independent claims, relates to an additive composition (and to fluids including such an additive as well as to methods of using such additives and fluids) which includes at least two dispersants and a metal-containing, overbased detergent. The first dispersant contains both phosphorus and boron. The second dispersant also contains boron, but is free of phosphorus.

Error Related to Rejections Based on the Srinivasan '441 Application

Srinivasan '441 fails to disclose the combination of at least two dispersants. Further, Srinivasan '441 fails to disclose the combination of a phosphorus- and boron-containing dispersant and a boron-containing dispersant, free of phosphorus. Srinivasan '441 discloses the use of either a phosphorus-containing dispersant or a boron containing dispersant (¶ 0046). Most preferably, Srinivasan '441 discloses the use of a *single* dispersant which includes both phosphorus and boron (¶ 0058 and Table I).

Therefore, an essential element of the claims is not met by Srinivasan '441 and a *prima facie* rejection is not made.

Error Related to Rejections Based on the Chrisope Patent and the Srinivasan '441 Application

Chrisope does not disclose or suggest the use of an overbased detergent, as the Examiner concedes. Further, the Chrisope patent would clearly lead one of ordinary skill away from the use of a metal-containing detergent. In fact, the entire point of the Chrisope patent is to provide a composition which is "devoid" of metal-containing components (Col. 1, lines 33 - 34). See also Claims 1 and 17, the only independent claims of the Chrisope patent. Both claims explicitly specify a composition which is "devoid or essentially devoid of metal-containing components." While the Chrisope patent may make passing reference to "metal-containing detergents" (Col. 12, lines 5 - 10), their use is clearly non-preferred according to Chrisope. Further, the use of a metal-containing detergent may not contain more than 100 ppm of metal (Col. 12, lines 5-10), which would be clear to one of skill in the art as not being an overbased detergent.

Thus, there is no motivation for one of skill in the art to combine Chrisope with Srinivasan '441. Chrisope teaches away from using metal-containing detergents, and furthermore, does not disclose overbased, metal-containing detergents. The Federal Circuit has clearly indicated that if a proposed modification to the art would render it "inoperable for its intended purpose", the reference, "in effect ... teaches away from the ... proposed modification." *In re Gordon*, 221USPQ 1125 (Fed. Cir. 1984). It is, therefore, an error for the Examiner to make a combination that would render the Chrisope patent inoperable for its intended purpose.

Error Related to Rejections Based on the Srinivasan '236 Patent and the Srinivasan '441 Application

Srinivasan '236 does not disclose or suggest the use of an overbased detergent, as the Examiner concedes. Further, Srinivasan '236 would clearly lead one of ordinary skill away from the use of a metal-containing detergent. In fact, the entire point of Srinivasan '236 is to provide a composition having "little or no content of metals." (Col. 1, lines 35 – 37). Although the Srinivasan '236 patent refers to the possibility of using "very small amounts" and "no more than 100 ppm of metal" of metal-containing detergents, the overall teaching of the reference would lead one of ordinary skill away from the use of any metal-containing detergent. (Col. 12, lines 27-36). Further, the Srinivasan '236 patent teaches away from the use of overbased detergents. According to Srinivasan '236, any detergents used are preferably "neutral salts," which one of skill in the art would recognize as not being overbased. (Col. 12, line 33).

Thus, there is no motivation for one of skill in the art to combine Srinivasan '236 with Srinivasan '441. Srinivasan '236 teaches away from using metal-containing detergents, and furthermore, does not disclose overbased, metal-containing detergents, like Chrisope. The Federal Circuit has clearly indicated that if a proposed modification to the art would render it "inoperable for its intended purpose", the reference, "in effect ... teaches away from the ... proposed modification." *In re Gordon*, 221USPQ 1125 (Fed. Cir. 1984). It is, therefore, an error for the Examiner to make a combination that would render the Srinivasan '236 patent inoperable for its intended purpose.

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Fees

Please debit a fee of \$450 from Deposit Account No. 12-2355 for a two-month extension of time pursuant to 37 C.F.R. 1.17(a)(1). In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Conclusion

It is therefore respectfully requested that the rejections be withdrawn and the claims be allowed.

Respectfully submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

By:



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June 07, 2007
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